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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,746	03/29/2004	Jacob Guth	05408/100M675-US1	5468
7278 7590 04/25/2007 DARBY & DARBY P.C. P. O. BOX 5257 NEW YORK, NY 10150-5257			EXAMINER MARX, IRENE	
			ART UNIT	PAPER NUMBER
			1651	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		04/25/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/812,746

Applicant(s)

GUTH ET AL.

Examiner

Irene Marx

Art Unit

1651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 11-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 14-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

The application should be reviewed for errors.

To facilitate processing of papers at the U.S. Patent and Trademark Office, it is recommended that the Application Serial Number be inserted on every page of claims and/or of amendments filed.

Applicant's election without traverse electing to prosecute the invention of Group I, claims 1-10 and 14-19 directed to compositions containing L-carnitine on 2/28/07 is acknowledged.

Claims 1-10 and 14-19 are being considered on the merits. Claims 11-13 are withdrawn from consideration as directed to a non-elected invention.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-10 and 14-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 14 are vague, indefinite and confusing in the recitation of "an effective amount of L-carnitine, an acyl L-carnitine, a salt thereof or a mixture thereof". Because of the inclusion of "or a mixture thereof", it is at least ambiguous whether both L-carnitine and an acyl L-carnitine are or are not required to be in the composition. If both are required, the phrase "or a mixture thereof" appears redundant. Also, the antecedent basis for "or a salt thereof" is ambiguous and unclear.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Paul.

The claims appear to be directed to a topical composition comprising L-carnitine or an acyl L-carnitine and one or more of hydroxy acids, proteolytic enzymes, skin lightening agents as topical preparations.

The reference discloses topical compositions comprising L-carnitine and a hydroxy acid. See, e.g., col. 3. Glycolic acid is a preferred hydroxy acid (col. 15, line 16).

Claims 1-9 and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paul in view Cavazza et al., Johnsen, Vromen, Yu *et al.* and Deckner *et al.* (U.S. Patent No. 5,968,528).

The claims appear to be directed to a topical composition comprising L-carnitine or an acyl L-carnitine and one or more of hydroxy acids, proteolytic enzymes, skin lightening agents as topical preparations.

Paul discloses topical compositions comprising L-carnitine and a hydroxy acid. See, e.g., col. 3 and 6. Glycolic acid is a preferred hydroxy acid (col. 15, line 16).

The reference differs from the invention as claimed in that the pH is not disclosed and in the presence of various components.

However, Cavazza discloses the use of various additives in cosmetic compositions. See, e.g., page 8. In addition, Johnsen discloses that the pH for cosmetics is favorable in the range of 5.5 to 7 (col. 5). In addition, Vromen adequately demonstrates that proteolytic enzymes such as papain are routinely added to cosmetic or topical compositions. See, e.g., col. 2.

With regard to the use of skin bleaching agents, Yu *et al.* adequately demonstrate that it is old in the art to add various materials to cosmetic compositions, such as skin bleaches. See, e.g., col. 2. In addition, Deckner *et al.* teach the specific skin lighteners kojic acid and arbutin (col. 31, lines 40-60). This reference also discloses the use of hydroxy acids such as salicylic, glycolic and lactic in topical compositions. See, e.g., col. 31, lines 1-12. Moreover, the use of carnitine in such compositions is disclosed at col. 24, line 22. Deckner teaches that the pH should preferably be between 5 to 8. (Col. 10, line 15.)

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It would have been obvious to one having ordinary skill in the art at the time the claimed invention was made to modify the compositions of Paul containing L-carnitine by using various additives to the cosmetic composition and keeping the pH at between 5.5 and 7 for example, and using various additives such as proteolytic enzymes, bleaches, lighteners, etc. as suggested by the teachings of Cavazza et al., Johnsen, Vromen, Yu et al. and Deckner *et al.* for the expected benefit of providing a topical composition suitable for rejuvenating ageing skin.

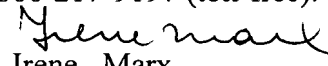
Thus, the claimed invention as a whole was clearly *prima facie* obvious, especially in the absence of evidence to the contrary.

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irene Marx whose telephone number is (571) 272-0919. The examiner can normally be reached on M-F (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Irene Marx  
Primary Examiner  
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